

REMARKS

Amendments

Claim 8 is cancelled. Claim 1 is amended to use language in accordance with conventional US practice. Claim 12 is amended to correct a typographical error. Claim 12 is also amended to depend from claim 1. New claims 22-24 are directed to further aspects of the invention and are supported throughout the disclosure. See, for example, page 12, last paragraph, page 19, second paragraph, and Table 4. New claims 25-26 are directed to certain water soluble binders of claim 1.

Restriction Requirement

In the Office Action issued June 17, 2010, the Examiner presented a Restriction Requirement whereby the claims were restricted into two Groups: Group I, claims 1-11, drawn to impregnated paper; and Group II, claims 12-16, drawn to a method of making impregnated paper. In response to the Restriction, applicants elected Group I, claims 1-11. The Restriction was traversed.

In the recent Office Action issued July 29, 2010, the Examiner presents a new Restriction Requirement. In this new Restriction Requirement, the claims are divided into four Groups: Group I, claims 1-4, 7-11, and 17-19 drawn to impregnated paper; Group II, claims 12-16, drawn to a method of making impregnated paper; Group III, claim 20, drawn to impregnated paper; and Group IV, drawn to a method of making impregnated paper. Applicants hereby reaffirm the election of Group I. However, the Restriction Requirement is again respectfully traversed.

The Restriction asserts that Groups I-IV lack the same or corresponding technical feature. In support of this assertion, it is argued that applicants' claim 1 is obvious or anticipated by Wicher et al. (EP 0 697 622). However, the fact that the Office Action presents no rejection of claim 1 in view of Wicher et al. (EP 0 697 622) clearly contradicts the basis for the Restriction.

Moreover, merely providing a machine translation of Wicher et al. (EP 0 697 622) does not demonstrate how the Wicher et al. disclosure anticipates or renders obvious applicants' claim 1. For example, the Restriction fails to demonstrate how the disclosure of Wicher et al. describes or suggests a paper with a high penetration resistance to fats and oils.

Further, the Restriction does not demonstrate how the disclosure of Wicher et al. describes or suggests a paper that is produced from strongly beaten pulps with a degree of beating of 15⁰SR to 90⁰SR, and/or a paper that is internal sized with alkenyl succinic anhydride and/or alkyl ketene dimers (AKD) and/or resin sizes, and/or an impregnating liquor which contains a binder system of 80 to 100 parts by mass of water-soluble binders. Additionally, the Restriction fails to demonstrate how the disclosure of Wicher et al. describes or suggests the binders recited in applicants' amended claim 1.

In addition, Group I and Group III are directed to the same subject matter, i.e., impregnated paper. The Restriction provides no rationale as to why the subject matter of Group I should be restricted from the subject matter of Group III. Similarly, Group II and Group IV are directed to the same subject matter, i.e., a method of making impregnated paper. The Restriction provides no rationale as to why the subject matter of Group II should be restricted from the subject matter of Group IV.

In view of the above remarks, it is respectfully submitted that the Office Action fails to set forth sufficient rationale to justify a restriction under PCT Rules 13.1 and 13.2.

Withdrawal of the Restriction is respectfully requested.

Information Disclosure Statement

In the Office Action, it is stated that the references B1-B4 have not been considered because copies were not provided. It is noted that machine translations of references B1 and B2, EP 0 545 043 and EP 0 697 622, have been made of record by the Examiner. In addition, references B3 and B4 correspond to CA 2,100,117 and US 6,294,265, respectively, which are already of record. For the Examiner's convenience, copies of references B1-B4 are provided herewith.

Rejection under 35 USC 112, second paragraph

Claims 1-4, 7-11, and 17-18 are rejected as being indefinite under 35 USC 112, second paragraph. This rejection is respectively traversed.

In the rejection it is argued that claim 1 recites both the broad term "water-soluble binders" and a narrower term within this broader term, i.e. "ethylene-vinyl alcohol copolymers, acetalized ethylene-vinyl alcohol copolymers, ..., polyvinyl alcohols containing carboxyl groups, and mixtures thereof." Contrary to the assertion in the rejection, this

language does not render the claim indefinite.

The language in question properly sets forth a Markush group that defines the literal scope of “water-soluble binders” in the claim. See, for example, MPEP 2173.05(h) Alternative Limitations. Furthermore, it is noted that members of a Markush group may overlap. For example, it is permissible for the members of a Markush group to include both halogen and chloro, even though “halogen” is generic to “chloro.” Here again, see MPEP 2173.05(h).

In any event, the language of claim 1 is sufficiently clear that one of ordinary skill in the art can readily determine whether a given embodiment is within or outside the literal scope of the claim. Nothing more is required under the statute. Withdrawal of the rejection is respectfully requested.

Rejection under 35 USC 102(b)/103(a) in view of Schoeller

Claims 1-19 are rejected as being anticipated or obvious in view of Schoeller et al. (EP 0 545 043). This rejection is respectfully traversed.

Firstly, applicants note that this rejection is applied against “Claims 1-19,” which includes withdrawn claims 12-16. Thus, clarification of the status of claims 12-16 is requested.

To establish anticipation, the rejection must indicate where the asserted anticipatory reference discloses each feature of the rejected claim. See, e.g., *Ex parte Levy*, 17 USPQ2d 1461, 1462 (POBA 1990) [“Moreover, it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.”]. In the instant case, the rejection clearly fails to set forth where each feature of the claimed invention is described by Schoeller et al. (EP ‘043).

In general, Schoeller et al. disclose a base paper for use in photographic supports. The paper is made from recycled material or a mixture of recycled material and standard cellulose or photo cellulose. The pulp contains 5-100% recycled material.

In the rejection, it is argued that Schoeller et al. (EP ‘043) disclose a paper that has been sized with alkenyl succinic anhydride and/or alkyl ketene dimers. Further, it is asserted in the rejection that the paper disclosed by Schoeller et al. (EP ‘043) is impregnated with a “water-soluble binder.” In terms of identifying where these features are disclosed by Schoeller et al. (EP ‘043), the rejection merely refers to “entire document, Examples 1-3.”

The rejection clearly fails to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. For example, the rejection asserts that the Schoeller et al. is impregnated with a water-soluble binder. But, the rejection does not state where the binder is disclosed in the reference, or what that binder is.

Asserting that Schoeller et al. disclose impregnating the paper with a “water-soluble binder” does not demonstrate that Schoeller et al. disclose a binder in accordance with applicants’ claimed invention. See, for example, claim 1 wherein the water soluble binder is selected from ethylene-vinyl alcohol copolymers, acetalized ethylene-vinyl alcohol copolymers, acetalized polyvinyl alcohols, polyvinyl butyrals, cationically modified polyvinyl alcohols containing silanol groups, acetalized cationically modified polyvinyl alcohols containing acetalized silanol groups, polyvinyl alcohols containing carboxyl groups, and mixtures thereof. The rejection fails to demonstrate where Schoeller et al. disclose or even suggest the use of any of these particular binders.

The reference to the “entire document” in the rejection does not identify where any feature of the claimed invention is disclosed by Schoeller et al. With regards to Examples 1-3, from the mechanical translation, it appears that Example 1, Schoeller et al. disclose a paper made from fibrous mixtures (listed in Table 1) treated with “neutral sizing agents” comprising a mixture TiO₂, white toner, anionic starch, polyamide/polyamine-epichlorohydrin resin, alkyl ketene dimmer, and epoxidized fatty acid amide. The paper is subsequently “surface-glued” with a solution of oxidized starch, white toner, and NaCl. Example 1 does not disclose a water soluble binder in accordance with applicants’ claim 1.

Example 2 is said to be analogous to Example 1, except that the initial fibrous mixtures are in accordance with those listed in Table 2, i.e., (a) 90 wt % photocellulose and 10 wt % recycled material, (b) 50 wt % photocellulose and 50 wt % recycled material, and (c) 100 wt % recycled material. Example 2 also does not disclose a water soluble binder in accordance with applicants’ claim 1.

Also, from the mechanical translation, it appears that Example 3 discloses a paper made from a fibrous mixture containing 30 wt% recycled material and 70 wt% hardwood sulfate cellulose (photocellulose) which is then treated with sizing agents comprising a mixture of white toner, “anion,” polyacrylamide, stearin, alum, “kat. polyacrylamide,” and polyamide/polyamine-epichlorohydrin resin. The paper is subsequently “surface-glued” with

a solution of polyvinyl alcohol, CaCl₂, and white toner. Thus, Example 3 also does not disclose a water soluble binder in accordance with applicants' claim 1.

Furthermore, with regards to the asserted obviousness, the rejection presents no rationale as to why one skilled in the art would modify the paper of Schoeller et al. so as to use a binder in accordance with applicants' claimed invention.

It is noted that at the top of page 2 of the mechanical translation, Schoeller et al. surface sizing ("Oberflächenleimung") with polyvinyl alcohol. Sizing at the surface does not suggest impregnating the paper in accordance with the claimed invention wherein the binder actually penetrates the paper and thus provides higher fat and oil resistance than surface sizing.

Additionally, as noted above, Schoeller et al. disclose a base paper for use in photographic supports. To readily absorb the water-based inks, a photographic paper will need to be hydrophilic. Conversely, fat and oil resistance paper should be hydrophobic in order to withstand the hydrophobic fat and oil.

In the rejection, it is argued that the claims are considered product-by process claims due to the recitation of strongly beaten pulps with a degree of beating of 15 °SR to 90 °S. It is unclear what is intended by this assertion. The recitation of strongly beaten pulps with a degree of beating of 15 °SR to 90 °S merely describes material used in making the paper. The recitation only characterizes the starting material used to make the paper as a product-by-process. The overall subject matter claimed is clearly a product, i.e., a paper impregnated with a specific impregnating liquor.

Moreover, reference to "product-by-process" does not obviate the showings required for an obviousness rejection as set for by the Supreme Court the *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). An obviousness rejection requires determining the scope and content of the prior art and ascertaining the differences between the claimed invention and the prior art. Thereafter, a rationale must be presented as to why these differences are held to be obvious. The present rejection does not identify the differences or present a rationale as to why they would be obvious. Instead, the rejection makes the unsupported conclusion that, if there are any differences between the claimed invention and the prior art, these differences are obvious.

The rejection fails to set forth reasoning why it would be obvious to modify the paper

of Schoeller et al. to use a binder in accordance with applicants' claim 1. Additionally, the rejection presents no rationale as to why it would be obvious to modify the paper of Schoeller et al. so as to exhibit features in accordance with features recited in applicants' various dependent claims such as smaller subgenera of binders, crosslinking agents, concentration of the impregnating liquor, coating weight of the impregnating liquor, etc.

In view of the above remarks, it is respectfully submitted that the rejection fails to establish that the disclosure of Schoeller et al. anticipates the claimed invention in accordance with 35 USC 102(b). In addition, in view of the above remarks, it is respectfully submitted that the disclosure of Schoeller et al. fails to render obvious the claimed invention in accordance with 35 USC 103(a). Withdrawal of the rejection is respectfully submitted.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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